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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,560	07/25/2003	Eric L. Andersen	200209473-1	5231

22879 7590 08/26/2005

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EXAMINER

MORRISON, THOMAS A

ART UNIT PAPER NUMBER

3653

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,560

Applicant(s)

ANDERSEN ET AL.

Examiner

Thomas A. Morrison

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 22-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/25/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-21 in the reply filed on June 2, 2005 is acknowledged. The traversal is on the ground(s) that a reasonable example has not been provided to show that the process can practiced by another materially different apparatus. This is not found persuasive, because the process of claim 22 of the instant application can be practiced using an apparatus that does not have a media output unit configured for attachment to one side of the image forming device and stacked above the media input unit, as required in independent claim 10 of the instant application. Moreover, the process of claim 22 is silent as to non-imaged print media, as required in independent claim 16 of the instant application. In addition, the process of claim 22 is silent as to a media feeder and positioning of such media feeder, as required in independent claim 1 of the instant application. Rather than the media feeder set forth in independent claim 1, media can, e.g., be input by hand into the duplex media path set forth in the method of claim 22. Since the process of claim 22 and its dependent claims 23-30 can be practiced by another materially different apparatus or by hand, the restriction is proper. Applicant did not make any specific arguments for claim 31. In any event, the method of claim 31 can also be practiced by another materially different apparatus, or by hand. In claim 31 of the instant application the step of providing access to the return media path through a side of the image forming device could possibly be performed, e.g., via providing some sort of door mechanism on the side of the image forming device, which can be opened by a mechanism or by hand.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claim 10 is objected to because of the following informalities: (1) the recited "stacked above of the media input unit" in line 12 of claim 10 should be -- stacked above the media input unit --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the image forming device" in line 3. There is insufficient antecedent basis for this limitation in the claims.

Regarding claim 10, it is unclear if the recited "an image forming device" in lines 7-8 is the same or different from the previously recited "an image forming device" in lines 1-2.

Claim 16 recites the limitation "the image forming device" in line 6. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6-7, 9-14, 16-18 and 20-21, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,348,101 (Schonfeld et al.). In particular, the Schonfeld et al. patent discloses the limitations of claims 1-4, 6-7, 9-14, 16-18 and 20-21.

Regarding claim 1, Figs. 1 shows a media handling system for an image forming device (110) configured with a primary media path (from 72 to 84 and then from 88 past 90 and over to 98) and a duplex media path (from near 102 to 100 and then past 74 and 82 and back over to 80 for re-feeding to an imaging forming device), the media handling system comprising:

a media feeder (including 70 and 74) positioned adjacent to one side (left-hand side) of the image forming device (12) and configured to input print media into the duplex media path of the image forming device (110).

Regarding claim 2, Fig. 1 shows that the duplex media path is a substantially horizontal media path.

Regarding claim 3, Fig. 1 shows that the media feeder (including 70 and 74) is configured to automatically input non-imaged media into the duplex media path of the image forming device. See also Fig. 7.

Regarding claim 4, Fig. 1 shows that the media feeder (including 70 and 74) includes a high-capacity media storage unit (70) to store a quantity of media. See also Fig. 6 which shows a stack of media.

Regarding claim 6, Fig. 1 shows a media output unit (including 104) configured to be positioned adjacent to the one side (left-hand side) of the image forming device (110) to receive media discharged from the image forming device (110).

Regarding claim 7, Fig. 1 shows that the media feeder (including 70 and 74) and the media output unit (104) are configured to be vertically-stacked to reduce a footprint of the image forming device (110).

Regarding claim 10, Fig. 1 shows a media handling apparatus for inputting non-imaged media into an image forming device having a primary media path (from 72 to 84 and then from 88 past 90 and over to 98) along which an image is formed on a print media, the handling apparatus comprising:

a return media path (from near 102 to 100 and then past 74 and 82 and back over to 80 for re-feeding to an imaging forming device) configured to selectively receive imaged print media from the primary media path and return the imaged media to the primary media path for multiple imaging;

a media input unit (including 70) configured for attachment to one side of an image forming device (12) to input non-imaged media into the return media path of the image forming device (i.e., see also Figs. 6-7); and

a media output unit (including 104) for receiving imaged media discharged from the primary media path, the media output unit (including 104) being configured for attachment to the one side (left-hand side) of the image forming device and stacked above of the media input unit including 70).

Regarding claim 11, Fig. 1 shows that the return media path is a substantially horizontal path.

Regarding claim 12, Fig. 1 shows that the media input unit (including 70) further comprises a media storage unit (70) to store a quantity of non-imaged media. See also Figs. 6-7.

Regarding claim 14, Fig. 1 shows that the media input unit (70) is configured to be detachably mounted to the one side (left-hand side) of the image forming device (110).

Regarding claim 16, Fig. 1 shows an image forming apparatus comprising:

a housing (near numeral 110) having at least one wall;

an image forming unit (including 12) provided within the housing for forming an image onto print media;

a media storage unit (70) configured to store a supply of non-imaged print media (i.e., see also Fig. 6);

a primary media path (from 72 to 84 and then from 88 past 90 and over to 98) for carrying print media to the image forming device (12) for imaging;

a duplex media path (from near 102 to 100 and then past 74 and 82 and back over to 80 for re-feeding to an imaging forming device) configured to receive imaged print media from the primary media path and return the imaged print media to the primary media path for duplex imaging; and

the duplex media path (from near 102 to 100 and then past 74 and 82 and back over to 80 for re-feeding to an imaging forming device) being configured to receive non-imaged print media from the media storage unit (70) and to input the non-imaged print media to the primary media path for imaging.

Regarding claim 17, Fig. 1 shows a media output unit (including 104) positioned to receive imaged print media discharged from the primary media path where the media storage unit (70) and the media output unit (including 104) are stacked to reduce a footprint of the image forming apparatus.

Regarding claim 18, Fig. 1 shows a media feeder (74) to feed the non-imaged print media from the media storage unit (70) to the duplex media path.

Regarding claims 9, 13 and 20, Fig. 1 shows that the media output unit (including 104) includes a media finishing device. In particular, the media output unit (including

104) has a curved section to flip over printed media after it is printed and such flipped over media is then fed by rollers 106 into a holder 108. This ensures that the printed side of the printed media faces downward in the holder 108. See also column 10, lines 47-52.

Regarding claim 21, column 8, line 23 to column 10, line 55 discloses logic to determine whether print media is inputted into the primary media path or the duplex media path.

5. Claims 1, 2 and 4-8, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,365,886 (Murakami et al.). In particular, the Murakami et al. patent discloses the limitations of claims 1, 2 and 4-8.

Regarding claim 1, Figs.3-4 and the abstract disclose a media handling system for an image forming device (1) configured with a primary media path (from 21 up to near 17 and then back over and down to near 51) and a duplex media path (from 36 over to near 17 for re-feeding to an imaging forming device), the media handling system comprising:

a media feeder (including 35) positioned adjacent to one side (right-hand side) of the image forming device (1) and configured to input print media into the duplex media path of the image forming device (1).

Regarding claim 2, Figs. 3 shows that the duplex media path is a substantially horizontal media path.

Regarding claim 4, Fig. 3 shows that the media feeder (including 35) includes a high-capacity media storage unit (36) to store a quantity of media.

Regarding claim 5, Fig. 3 shows that the media feeder (including 35) is configured to be detachably mounted to the one side of the image forming device (1). In particular, Figs. 2-3 show how the unit 31 that contains the media feeder (including 35) is detachably mounted.

Regarding claim 6, Fig. 3 shows a media output unit (38) configured to be positioned adjacent to the one side (right-hand side) of the image forming device (1) to receive media discharged from the image forming device (1).

Regarding claim 7, Fig. 3 shows that the media feeder (including 35) and the media output unit (38) are configured to be vertically-stacked to reduce a footprint of the image forming device (1).

Regarding claim 8, Fig. 3 shows that the media feeder (including 35) and the media output unit (38) are integral within a housing (31).

6. Claims 1-4 and 16-19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,918,490 (Stemmle). In particular, the Stemmle patent discloses the limitations of claims 1-4 and 16-19.

Regarding claim 1, Fig. 1 shows a media handling system for an image forming device (10) configured with a primary media path (from 72 up to near 58 and past 82, 84 and 67) and a duplex media path (from 67 back to 94 and past 90, 102 and 76), the media handling system comprising:

a media feeder (including 70 and 76) positioned adjacent to one side (below) of the image forming device (10) and configured to input print media into the duplex media path of the image forming device (10).

Regarding claim 2, Fig. 1 shows that the duplex media path is a substantially horizontal media path.

Regarding claim 3, Fig. 1 shows that the media feeder (including 70 and 76) is configured to automatically input non-imaged media into the duplex media path of the image forming device (10).

Regarding claim 4, Fig. 1 shows that the media feeder (including 70 and 76) includes a high-capacity media storage unit (70) to store a quantity of media.

Regarding claim 16, Fig. 1 shows an image forming apparatus (10) comprising:
a housing (near 18) having at least one wall;
an image forming unit (20) provided within the housing (near 18) for forming an image onto print media;

a media storage unit (70) configured to store a supply of non-imaged print media;
a primary media path (from 72 up to near 58 and past 82, 84 and 67) for carrying print media to the image forming device (20) for imaging;

a duplex media path (from 67 back to 94 and past 90, 102 and 76) configured to receive imaged print media from the primary media path and return the imaged print media to the primary media path for duplex imaging; and

the duplex media path (from 67 back to 94 and past 90, 102 and 76) being configured to receive non-imaged print media from the media storage unit (70) and to input the non-imaged print media to the primary media path for imaging.

Regarding claim 17, Fig. 1 shows a media output unit (near 86) positioned to receive imaged print media discharged from the primary media path where the media storage unit (70) and the media output unit (near 86) are stacked to reduce a footprint of the image forming apparatus (10).

Regarding claim 18, Fig. 1 shows a media feeder (76) to feed the non-imaged print media from the media storage unit (70) to the duplex media path.

Regarding claim 19, Fig. 1 shows that the media storage unit (70) and the media output unit (near 86) are contained within a common housing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

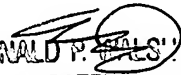
7. Claims 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Schonfeld et al. patent. Fig. 1 of Schonfeld et al. shows most of the limitations of claims 15 and 19, but does not specifically show that the media input unit and the media output unit being integral within a common housing. It would be obvious to one of ordinary skill in the art at the time the invention was made, to provide the media input unit and the media output unit within a common housing, in order to reduce the number of different parts in the image forming apparatus and reduce the manufacturing cost.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on (571) 272-6944. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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